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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,372	12/08/2000	Paul R. Petersen	M00-175100	1974

7590

05/28/2004

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EXAMINER
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THOMPSON JR, FOREST

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/733,372

Applicant(s)

PETERSEN, PAUL R.

Examiner

Forest Thompson Jr.

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My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper #2). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.

2. This action is responsive to the amendment A filed on 03/18/2004 (see Paper #3). Applicant amended claims 1, 3, 8, 10, 15, and 17, and cancelled claims 2, 9, and 16. Claims 1, 3-8, 10-15, and 17-21 are pending.

3. Claims 1, 3-8, 10-15, and 17-21 have been examined.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-21 were rejected in Paper #2 under 35 U.S.C. 103(a) as being unpatentable over the combination of Sipple et al. (U.S. Patent No. 6,405,327), alSafadi et al. (U.S. Patent No. 6,467,088), Smith et al. (U.S. Patent No. 5,848,250), and Katz et al. (U.S. Patent No. 6,055,513). Applicant's amendment cancelled claims and added features to the independent claims. Examiner has modified the previous rejection to encompass applicant's amended claim aspects, and reject all of claims 1, 3-8, 10-15, and 17-21 below.

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5. Claims 1, 3-8, 10-15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sipple et al. (U.S. Patent No. 6,405,327), alSafadi et al. (U.S. Patent No. 6,467,088), Smith et al. (U.S. Patent No. 5,848,250), and Katz et al. (U.S. Patent No. 6,055,513).

Claims 1, 3-8, 10-15, and 17-21: Applicant's invention of a system that facilitates a purchase of merchandise by a customer or user is taught in the following identified prior art. Applicant's invention teaches a method for determining upgrade requirements for a computer system (specifically, a memory upgrade). However, the invention is taught by an upgrade of any device/software/hardware/system, which is taught by prior art that disclose determining system upgrades and making purchases on-line. Specific prior art that, when combined, teach applicant's invention include:

(a) Sipple et al. teaches performance monitoring of a user system to determine possible system upgrades that would improve performance of the system. System performance is monitored and compared to previous performance data to identify performance degradation or limitations that may be overcome by upgrades to the system. Sipple et al. also identifies specific upgrades that could impact system performance problems. (Abstract). Additionally, Sipple et al. teaches:

- an easy-to-understand informational message is provided to a user such as a computer operator identifying subsystems that are performance inhibitors along with suggestions of specific upgrade solutions that will address the identified performance problems (col. 6 lines 24-29).

- the automatic performance monitoring procedure preferably only obtains results from three of the computer subsystems, namely: 1) the instruction processor, 2) the memory, and 3) the input/output processor (col. 10 lines 9-12).
- Block 1066 then receives control from block 1062 via interface 1065. Block 1066 will notify the computer operator of any performance limiters detected in block 1062 (col. 10 lines 63-65).
- In this example, the performance monitoring process 1100 has detected an actual performance limiter in the I/O processor of the computer system. The console display 1116 contains a simple message 1200 indicating a performance problem, and a suggested course of action for correcting the problem (in this case, a part number for an enhanced I/O processor unit) (col. 11 lines 8-14).
- A second message 1202 shown on the console display 1116 describes an early warning performance problem in the instruction processor subsystem. In this instance, the message provides the user with the actual percentage utilization of the subsystem. The message also includes a suggested course of action for correcting the problem (in this case, a part number for an enhanced instruction processor subunit) (col. 11 lines 17-23).

(b) alSafadi et al. teaches:

- a reconfiguration manager 10 interacts with an electronic device 12 also referred to as "Device X." The device 12 may represent a desktop, laptop or palmtop computer, a personal digital assistant (PDA), a telephone, television, set-top box or any other type of consumer electronic processing device. The device 12 includes a number of

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software components 14A, 14B and 14C, corresponding to version 1.1 of a software component A, version 2.3 of a software component B, and version 2.0 of a software component C, respectively. The reconfiguration manager 10 may be implemented on a computer, a set of computers, or any other type of data processing system or device.

(col. 3 lines 15-26)

- In operation, the reconfiguration manager 10 receives a request 20 from the device 12. In this example, the request 20 indicates that a user of the device 12 wants to upgrade the device to include version 2.0 of software component A. The request in the illustrative embodiment also includes a list of the components currently in the device, i.e., version 1.1 of component A, version 2.0 of component C and version 2.3 of component B. The request may include additional information, such as any needed information regarding the interconnection of the components or other parameters associated with the device. (col. 4 lines 12-22)

- In step 100, the reconfiguration manager 10 obtains information regarding the hardware and software configuration of device X, i.e., electronic device 12 of FIG. 1. This information is generally included as part of the request 20 sent by the device 12 to the reconfiguration manager 10. In other embodiments, this information may be obtained in another suitable manner, e.g., from a local database based on a serial number or other identifier of the electronic device. (col. 4 lines 39-47)

- a particular set of upgrade configuration is selected in step 116, and the upgrade is approved in step 118 as compatible with the current configuration of device X. The selection in step 116 may be based at least in part on one or more established criteria,

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such as least expensive, maximum improvement in system operating speed, most recently modified, most energy efficient, or other suitable criteria. The reconfiguration manager or other server associated therewith then downloads the upgrade to device X in step 120. (col. 5 lines 9-18)

- Information regarding the particular components in the device may be determined, e.g., by accessing a local database using the device identifying information, may be supplied directly by the user, or may be determined using combinations of these and other techniques. (col. 6 lines 22-27)

- The above-described embodiments of the invention are intended to be illustrative only. For example, the invention can be used to implement upgrading or other reconfiguration of any desired type of software or hardware component, as well as combinations of these and other components, for any desired type of electronic device, and in many applications other than those described herein. The invention can also be implemented at least in part in the form of one or more software programs which are stored on an otherwise conventional electronic, magnetic or optical storage medium and executed by a processing device, e.g., by the processors 220 and 230 of system 200. These and numerous other embodiments within the scope of the following claims will be apparent to those skilled in the art. (col. 6 lines 28-41)

(c) Smith et al. teaches:

- A system for upgrading a personal computer includes a motherboard having upgrade sockets for upgrading the CPU and the clock oscillator without the need to

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remove any components. The system includes sensing circuitry for detecting the type of component plugged into the upgrade socket and circuitry for disabling the upgraded component. In addition, the system includes software for reconfiguring various signals depending on the particular upgrade plugged into the upgrade socket. By providing a system that can be upgraded by merely inserting a newer component, upgrades can be performed rather quickly. In addition, the upgrade system allows the end user a plurality of upgrade options while at the same time allows the end user to take advantage of declining CPU prices. (Abstract)

- An important aspect of the invention is the ability of the system to provide multiple options with respect to the choice of CPU upgrades (col. 3 lines 8-10).

(d) Katz et al. teaches, in one aspect of the invention, goods, service or information are provided to the user via electronic communication, such as through a telephone, videophone or other computer link, as determined by the steps of first, establishing communication via the electronic communications device between the user and the system to effect a primary transaction or primary interaction, second, obtaining data with respect to the primary transaction or primary interaction, including at least in part a determination of the identity of the user or prospective customer, third, obtaining at least a second data element relating to the user, fourth, utilizing the primary transaction or primary interaction data along with the at least second data element as factors in determining at least one good, service or item of information for prospective upsell to



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the user or prospective customer, and offering the item to the prospective customer.

(Abstract)

Additionally, Katz et al. teaches automatically initiating the purchase transaction involves automatically initiating the purchase transaction through a website that facilitates purchasing the memory upgrade option, and the memory configuration information is automatically sent to the website so that the user does not have to reenter the memory configuration information in the teachings of:

- In yet further aspects of the consummation of either or both of the primary transaction or the derivative, upsell transaction, an order fulfillment system may be utilized. Upon receipt of indication that the transaction is to be consummated, the system may so designate the product, and may automatically provide for shipping and billing of the user. (col. 11 lines 56-62)
- In operation, a user establishes communication with a telemarketer (either with the user establishing communication in an inbound environment or with the telemarketer establishing communication in an outbound environment) or through other electronic contact, such as through a website contact or hit, upon which identity information regarding the user is either automatically obtained such as through the use of ANI or manually obtained, such as through entry of identification information by the user. The identity information may be specific to the user, or may be more generalized such as information relating to the type of primary transaction or interaction. A second data element is then obtained, preferably from a second, and most preferably remote,

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database which is then used in conjunction with the primary transaction or primary interaction data so as to select a subset of potential offers of goods, services or information to the user. Upon selection, the goods, services or information are provided to the user, and if the interaction is for the purpose of sale, the transaction is preferably consummated. In the preferred embodiment, inventory checks for the proposed offer, as well as a credit authorization for the proposed offer, are made during the course of the communication, and most preferably, prior to the offer of the secondary item. In yet another aspect, the inventions relate to the intelligent selection and proffer of goods, services or information based upon an initial contact generating at least partial identification data, utilizing a remote, external database to develop yet further identification or information respecting the user, utilizing the collected information in the selection of the good, service or information to be provided to the user, and providing the same to the user. (col. 11 line 63 – col. 12 line 26)

- Initially, a system user contacts the system for purpose of a primary transaction. As explained, however, the transaction need not be a consummated transaction. If the system user is a potential customer contacting a telemarketing system, at action (statement) block 10 a telemarketing operator may interact with the potential customer and take the order entry data for the primary transaction. Either upon completion of the primary transaction, such as through consummation of a sale or by program flow to further action prior to consummation of a sale, action (decision) block 12 is arrived at wherein data, such as order data or other primary transaction data is compared to one or more databases for analysis. The primary transaction may be a contact for a sale or

other commercial transaction, a service or repair transaction or interaction, or may be for the purpose of an inquiry. (col. 13 lines 52-68)

- Yet another aspect of basing the upsell selection on prior purchases may include upgrades to prior purchases. For example, where the system determines that the user has previously purchased a computer of a given make and model, the system may offer as an upsell a good or service particularly adapted to improve the performance of the system of the user, such as provision of additional memory, or other modified component. (col. 24 lines 36-45)

### ***Response to Arguments***

6. Applicant's arguments filed 03/18/2004 have been fully considered but they are not persuasive.

**Applicant argues**, at pg. 8-9, that the prior art does not teach automatically placing an order for a memory upgrade and automatically communicating the details of the memory upgrade upon receiving concurrence of the user.

**Examiner disagrees.** Katz teaches these aspects, as identified in the rejection in section 4.(d) above. Therefore, examiner maintains the rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

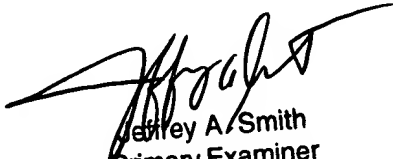
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT   
05/27/2004

  
Jeffrey A. Smith  
Primary Examiner